

REMARKS/ARGUMENTS

Applicant has carefully reviewed and considered the Office Action mailed on January 10, 2005, and the references cited therewith.

Claims 1, 3-5, 8-9, 13, and 16-17 are amended, claim 11 is canceled, and no claims are added; as a result, claims 1, 3-5, 8-9, 13, and 16-17 are now pending in this application.

Applicant respectfully submits that claims 1, 3-5, 8-9, 13, and 16-17 do not introduce any new subject matter and are intended to cover additional claimable subject matter fully supported by the originally filed specification. Support for the same can be found in the Applicant's originally filed specification on pages 8-10.

§101 Rejection of the Claims

Claims 16-17 were rejected under 35 USC §101 because the claimed invention was alleged to be directed toward non-statutory subject matter.

The Applicant has rewritten claims 16 and 17 to conform to the accepted format of a "Beauregard" method claim. That is, the claims now emphasize being a computer readable medium having instructions for causing a printing device to perform a method.

§112 Rejection of the Claims

Claims 8-9, 11, and 17 were rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

The Applicant has attempted to differentiate between historical document data and associated prior print setting selections, including a user's prior print setting selection preference, in a comparison with a current document. A selection is made based on such a comparison. Applicant respectfully submits that the amendments to claims 8-9, and 17 have overcome the above 112 rejections. Claim 11 has been canceled.

§102 Rejection of the Claims

Claim 5 was rejected under 35 USC §102(e) as being anticipated by Fan, et al., (U.S. Patent No. 6,757,081).

Claim 8 was rejected under 35 USC §102(b) as being anticipated by Miller, et al., (U.S. Patent No. 5,731,823).

Claims 9, 11, 13, and 17 were rejected under 35 USC §102(b) as being anticipated by Freeman, et al., (U.S. Patent No. 6,707,574).

Applicant does not admit that the Fan reference is indeed prior art and reserves the right to swear behind the same at a later date. Additionally, Applicant believes that the Freeman reference is actually a 102(e) reference having issued in 2004. As such, Applicant does not admit that the Freeman reference is indeed prior art and similarly reserves the right to swear behind the same at later date. Even in view of these points, Applicant believes that claims 5, 8, 9, 13, and 17 are distinguishable from the cited references for at least the following reasons. Claim 11 has been canceled.

Independent claims 5, 8, 9, and 17, as amended, each recite a print setting selection based on a comparison of a current document to prior document data and prior print setting selections, “including a user’s prior print setting preference”. From Applicant’s review of the above references, the Applicant is unable to find any description as to the same. As such, Applicant respectfully submits that each and every element and limitation is not present in the cited references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 102 rejections for the above independent claims, as well as those claims which depend therefrom.

§103 Rejection of the Claims

Claims 1, 4, and 16 were rejected under 35 USC §103(a) as being unpatentable over Yoshida (U.S. Patent No. 5,227,894) in view of Adams, et al., (U.S. Patent No. 6,315,379).

Claim 3 was rejected under 35 USC §103(a) as being unpatentable over Yoshida (U.S. Patent No. 5,227,894) and Adams, et al., (U.S. Patent No. 6,315,379) as applied to claim 1 above, and further in view of Miller, et al., (U.S. Patent No. 5,731,823).

Applicant’s independent claims 1 and 16, as amended, each recite a print setting selection based on a comparison of a current document to prior document data and prior print setting selections, “including a user’s prior print setting preference”. From the Applicant’s review of Yoshida and Adams, Applicant is unable to locate any description, teaching or suggestion for the same

As such, Applicant respectfully submits that each and every element and limitation is neither described, taught or suggested in the above references, either independently or in combination. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the above independent claims, as well as those claims which depend therefrom.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Charles F. Moore, at (360) 212-8369 to facilitate prosecution of this matter.

At any time during the pendency of this application, please charge any additional fees or credit overpayment to the Deposit Account No. 08-2025.

CERTIFICATE UNDER 37 CFR §1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AMENDMENT Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 7th day of April, 2005.

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